



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/757,206 | 01/09/2001 | R. Mark Halligan | 77901 | 1306 |

24628 7590 11/16/2004

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,206

Applicant(s)

HALLIGAN ET AL.

Examiner

Jan Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on August 30, 2004, wherein:

Claims 1-95 are currently pending;

No claims have been added;

No claims have been cancelled;

Claims 1, 71 and 81 have been amended.

Response to Amendment

Specification

2. The applicant has amended the abstract. Therefore, the objection to the abstract as being over the 150 word limit is hereby *withdrawn*.

Claim Objections

3. The applicant has amended claim 81 so that it is no longer in improper multiple dependent form. Therefore, this objection is hereby *withdrawn*.

Claim Rejections - 35 USC § 112

4. Claims 4-6, 8-70 and 74-95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant's specification does not disclose adequate structure for performing the recited function. For example, in claim 19, the applicant talks about a means for calculating from the specified security measures a security measures factor for a trade secret. What is the means for doing the calculation? How is the calculation performed? The applicant has provided

Art Unit: 3629

no formulas with which the applicant performs the calculation. The applicant has not defined how the security measure factor is determined. The applicant talks about a threshold value in the specification and never really defines how the threshold value is determined. How are the values weighted? How is the net present value of a trade secret calculated? How is the economic benefit factor calculated? How does one characterize whether the trade secret constitutes negative know-how? In claim 22, the applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations.

How are the security threats factors calculated?

Therefore, applicant is respectfully requested to specifically point out the means in the claim limitation and the functionality of these means in performing the steps or functions. (See MPEP Section 2181).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4-6, 8-70 and 74-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, how is the indexing performed, how are the trade secret drafts converted into trade secret application? How are the security measures specified? How are security threats specified? What are the six factors of a trade secret as enumerated in Section 757 of the First Restatement of Torts? How are the values weighted? What is a combinational trade secret?

Art Unit: 3629

What constitutes negative know-how? How does one create a specification of the type trade secret using alphabetic, numeric, or alphanumeric fields.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Donner (US 6, 263, 314).

Referring to Claim 1-95:

Donner discloses a system for providing documentation, analysis, auditing, and accounting of IP (which includes trade secrets), said system comprising:

a data processing means (Fig. 1 (6), Fig. 8 (250));

a user interface means (Fig. 7, Fig. 8 (264));

a mass data storage means (Fig. 1 (4)(5), Fig. 2);

a means for indexing (Fig. 3 (indicator collection organizing device));

a means for storing or archiving (Fig. 1 (4) (5), Fig. 2);

a means for associating (Fig. 1 (10), Fig. 3 comparison device);

a means for analyzing (col. 5, lines 5-17);

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and

Art Unit: 3629

held not to serve as a limitation on the claim (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997)).

1. Claims 1-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Elder (US 6,393, 406).

Elder discloses a system comprising:

data processing means (Fig. 3 (136);

user interface (Fig. 1 (20));

mass data storage means (Fig. 1 (15, 10, 30, 35, 40, 50) Fig. 3 (135)

printer means (Fig. 3 (137), Fig. 12 (118))

calculating means (Fig. 1 (400), Fig. 12 (772))

comparison or analysis means (Fig. 12 (773))

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997)).

Response to Arguments

Applicant's arguments filed August 30, 2004 have been fully considered but they are not persuasive.

The Examiner, applicant, and inventor had an opportunity to discuss the Examiner's position to the rejections in the last Office Action in a personal interview conducted at the USPTO on November 20, 2004.

2. The Examiner has renewed the rejection under 35 USC 112, first paragraph. As per the discussion that took place in the interview, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

3. The Examiner has renewed the rejection under 35 USC 112, second paragraph. This rejection was also discussed during the interview. As per the discussion, the Examiner contends that the claim language is indefinite and does not clearly define the claimed invention.

4. As for the rejection as to Claims 1-95 being rejected by Donner and Eder, the rejections have been maintained. It was discussed in the interview that, since the applicant has claimed a system in claims 1-95, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior art structure, the examiner should establish a prima facie case, and then the burden shifts to the applicant to prove

Art Unit: 3629

otherwise. Applicant has failed to meet this burden. It is the Examiner's position that both Donner and Eder disclose all the claimed structural limitations and that the disclosed structure is capable of performing the recited function.

5. Since applicant is claiming a system in this application, applicant must identify in the specification the corresponding structure or the equivalents for the "means for." It is the Examiner's position that the applicant has failed to make clear the corresponding structure or acts disclosed in the specification for the means plus function language.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600